

AMENDMENT UNDER 37 C.F.R. § 1.116
U.S. APPLN. NO. 09/520,890
ATTORNEY DOCKET NO. Q55501

REMARKS

Claims 1-37 have been examined on their merits.

Finality of Office Action

Applicant again submits that the Office Action dated May 20, 2004, improperly has been made final and thus respectfully solicits withdrawal of the finality of the Office Action. The reasons for soliciting withdrawal of the finality of the Office Action are set forth in the Petition to Withdraw Finality Under 37 C.F.R. § 1.181 filed on June 15, 2004, which is incorporated into the present Amendment by reference.

In the Petition, Applicant noted that the Office Action set forth at least one new ground of rejection that was not necessitated by Applicant's amendments.

With respect to claims 13, 15, 16, 19, 20, 22, 25, 26 and 28, these claims presently stand rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Patent No. 6,731,302 to Côté. Previously, claims 13, 15, 16, 19, 20, 25, 26 and 28 were rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Patent No. 6,480,201 to Fushiki *et al.* and claim 22 was rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 6,256,625 to Breyer *et al.* in view of Fushiki. Applicant successfully traversed the rejections of claims 13, 15, 16, 19, 20, 22, 25, 26 and 28 with a Rule 131 Declaration, effectively removing Fushiki *et al.* as a reference.

In the February 26, 2004 Rule 111 Amendment, claims 13, 15, 16, 19, 20, 22, 25, 26 and 28 were editorially amended. No substantive amendments were made.

Despite this, the Patent Office issued a Final Office Action, dated May 20, 2004, in which the Patent Office propounded a new rejection against claims 13, 15, 16, 19, 20, 22, 25, 26 and 28. In the Final Office Action at page 6, the Patent Office stated that the rejection was a new one. A reading of the rejection shows that the Patent Office cited Côté as “teaching retrieved images composed of at least one base image and secondary element from storage ... and merging the retrieved based image with the retrieved secondary image to form a page window....” For the first time in the Final Office Action dated May 20, 2004, the Patent Office cited Côté as allegedly teaching the particular features of the invention as recited in claims 13, 15, 16, 19, 20, 22, 25, 26 and 28. Yet, this new rejection is clearly directed to features that existed in the claims as originally filed, as discussed above. Thus, Applicant’s amendments could not have necessitated this new ground of rejection.

With respect to claims 1-12, 14, 17, 18, 21, 23, 24, 27 and 29-37, these claims presently stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 4,942,515 to Miyagaki *et al.* in view of U.S. Patent No. 6,731,302 to Côté. Previously, claims 1-12, 14, 17, 18, 21, 23, 24, 27 and 29-37 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 6,256,625 to Breyer *et al.* in view of Fushiki. Applicant successfully traversed the rejections of claims 1-12, 14, 17, 18, 21, 23, 24, 27 and 29-37 with a Rule 131 Declaration, effectively removing Fushiki as a reference.

Although Miyagaki *et al.* was submitted by the March 25, 2003 Information Disclosure Statement, MPEP § 706.07(a) states that a final rejection is improper when a new ground of rejection ***that was not necessitated by amendment*** to the claims is introduced by the Patent

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Office. As discussed below, a new ground of rejection was introduced by the Patent Office on claims that were either editorially amended, or not amended at all.

In the February 26, 2004 Rule 111 Amendment, claims 1-12 *were not amended* and claims 14, 17, 18, 21, 23, 24, 27 and 29-37 were editorially amended. No substantive amendments to claims 14, 17, 18, 21, 23, 24, 27 and 29-37 were made.

Critically, claims 1-12 were not amended at all, but the Patent Office maintains that Applicant's amendments necessitated a new ground of rejection. This cannot constitute a basis for citing new art, nor can one find a single new recitation in the claims that the new art is relied upon to teach. For the first time in the Final Office Action dated May 20, 2004, the Patent Office cited Côté as allegedly teaching the particular features of the invention recited in claims 1-12, 14, 17, 18, 21, 23, 24, 27 and 29-37. Yet, this new rejection is clearly directed to features that existed in the claims as originally filed, as discussed above. Thus, Applicant's amendments could not have necessitated this new ground of rejection.

For the reasons discussed above, Applicant again requests that the finality of the May 20, 2004 Office Action be withdrawn.

Substantive Response to Final Office Action

Applicant herein editorially amends claims 8, 9, 14-21, 23-27, 30-32 and 34-36. The amendments to claims 8, 9, 14-21, 23-27, 30-32 and 34-36 do not narrow the literal scope of the claims, are not made for reasons of patentability, and thus, do not implicate an estoppel in the application of the doctrine of equivalents.

Claims 1-37 are all the claims presently pending in the application.

1. Claims 13, 15, 16, 19, 20, 22, 25, 26 and 28 stand rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by Côté (U.S. Patent No. 6,731,302). Applicant traverses the rejection of claims 13, 15, 16, 19, 20, 22, 25, 26 and 28 for at least the reasons discussed below.

To support a conclusion that a claimed invention lacks novelty under 35 U.S.C. § 102, a single source must teach all of the elements of a claim. *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1379 (Fed. Cir. 1986). A claim is anticipated only if each and every element as set forth in the claim is found either expressly or inherently in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). A single source must disclose all of the claimed elements arranged as in the claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989). Rejections under 35 U.S.C. § 102 are proper only when the claimed subject matter is identically disclosed or described in the prior art. Thus, the cited reference must clearly and unequivocally disclose every element and limitation of the claimed invention.

Côté fails to teach or suggest a method for displaying a page window on a computer screen, wherein the page window is created by overlaying a retrieved secondary image on a retrieved base image, as recited in claim 13. Côté discloses, *inter alia*, a method and apparatus for creating a facial image. *See, e.g.*, Abstract of Côté. The Patent Office alleges that Côté discloses the retrieval of a base image and a secondary image and merging the two images to form a page window. While Côté discloses the retrieval of images, none of the retrieved images (eyes, ears, nose, mouth, etc.) is a base image, and certainly not a base image that is completely overlaid by a secondary image, as recited in claim 13. Côté discloses that the various

morphological components are connected with “reduced discontinuities at their juncture.” In other words, the various images are stitched together at their edges, and while two adjacent images might overlap at their junction, no image completely overlays another image due to the morphological component positioning requirements. *See, e.g.*, Fig. 3, col. 10, lines 33-50 of Côté. In sum, the page window recited in claim 13 is completely different than the facial image disclosed by Côté.

Based on the foregoing reasons, Applicant submits that Côté fails to teach or suggest all of the claimed elements as arranged in claim 13. Therefore, under *Hybritech* and *Richardson*, Côté clearly cannot anticipate the present invention as recited in independent claim 13. Thus, Applicant submits that claim 13 is allowable, and further submits that claims 15, 16, 19 and 20 are allowable as well, at least by virtue of their dependency from claim 13. Applicant respectfully requests that the Patent Office withdraw the § 102(e) rejection of claims 13, 15, 16, 19 and 20.

With respect to independent claim 22, Applicant submits that claim 22 is allowable at least for reasons analogous to those discussed above with respect to claim 13, in that Côté fails to teach or suggest a computer system adapted to displaying page windows, wherein the page window is created by overlaying a retrieved secondary image on a retrieved base image. Therefore, under *Hybritech* and *Richardson*, Applicant submits that claim 22 is allowable, and further submits that claims 25 and 26 are allowable as well, at least by virtue of their dependency from claim 22. Applicant respectfully requests that the Patent Office withdraw the § 102(e) rejection of claims 22, 25 and 26.

With respect to independent claim 28, Applicant submits that claim 28 is allowable at least for reasons analogous to those discussed above with respect to claim 13, in that Côté fails to teach or suggest a computer program product adapted to displaying page windows, wherein the page window is created by overlaying a retrieved secondary image on a retrieved base image. Therefore, under *Hybritech* and *Richardson*, Applicant submits that claim 28 is allowable, and respectfully requests that the Patent Office withdraw the § 102(e) rejection of claim 28.

2. Claims 1-12, 14, 17, 18, 21, 23, 24, 27 and 29-37 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Miyagaki *et al.* (U.S. Patent No. 4,942,515) in view of Côté. Applicant traverses the rejection of claims 1-12, 14, 17, 18, 21, 23, 24, 27 and 29-37 for at least the reasons discussed below.

The initial burden of establishing that a claimed invention is *prima facie* obvious rests on the USPTO. *In re Piasecki*, 745 F.2d 1468, 1472 (Fed. Cir. 1984). To make its *prima facie* case of obviousness, the USPTO must satisfy three requirements:

- a) The prior art relied upon, coupled with the knowledge generally available in the art at the time of the invention, must contain some suggestion or incentive that would have motivated the artisan to modify a reference or to combine references. *In re Fine*, 837 F.2d 1071, 1074 (Fed. Cir. 1988).
- b) The proposed modification of the prior art must have had a reasonable expectation of success, as determined from the vantage point of the artisan at the time the invention was made. *Amgen, Inc. v. Chugai Pharm. Co.*, 927 F.2d 1200, 1209 (Fed. Cir. 1991).

- c) The prior art reference or combination of references must teach or suggest all the limitations of the claims. *In re Vaeck*, 20 U.S.P.Q.2d 1438, 1442 (Fed. Cir. 1991); *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970).

The motivation, suggestion or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, the nature of a problem to be solved. *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). Alternatively, the motivation may be implicit from the prior art as a whole, rather than expressly stated. *Id.* Regardless of whether the USPTO relies on an express or an implicit showing of motivation, the USPTO is obligated to provide particular findings related to its conclusion, and those findings must be clear and particular. *Id.* A broad conclusionary statement, standing alone without support, is not “evidence.” *Id.*; *see also, In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001).

In addition, a rejection cannot be predicated on the mere identification of individual components of claimed limitations. *In re Kotzab*, 217 F.3d 1365, 1371 (Fed. Cir. 2000). Rather, particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed. *Id.*

The Patent Office acknowledges that Miyagaki *et al.* fail to teach or suggest the use of base and secondary images. *See* May 20, 2004 Final Office Action, page 4. The Patent Office alleges that Côté provides the necessary disclosure to overcome the acknowledged deficiencies of Miyagaki *et al.*

The combination of Miyagaki *et al.* and Côté fails to teach or suggest a method for displaying a page window on a computer screen, wherein the page window is created by overlaying a retrieved secondary image on a retrieved base image, as recited in claim 1. The Patent Office has acknowledged that Miyagaki *et al.* fail to use base and secondary images, so the Patent Office must rely on the disclosure of Côté. As discussed above, Côté discloses, *inter alia*, a method and apparatus for creating a facial image. *See, e.g.*, Abstract of Côté. While Côté discloses the retrieval of images, Côté also discloses that the various morphological components are connected with “reduced discontinuities at their juncture.” In other words, the various images are stitched together at their edges, and while two adjacent images might overlap at their junction, no image completely overlays another image due to the morphological component positioning requirements. *See, e.g.*, Fig. 3, col. 10, lines 33-50 of Côté. The combination of Miyagaki *et al.* with Côté does not render the invention recited in claim 1 obvious. Although the Patent Office alleges that the multiple images of Côté could be used in the system of Miyagaki *et al.*, those images would appear in specific locations on the resultant screen. Moving those images to other portions of the resultant screen or overlaying those images would be contrary to the disclosure of Côté¹, and any allegation that either reference teaches overlaying (as recited by the claim 1 of the instant application) would be hindsight reconstruction on the part of the Patent Office. There is simply no teaching or suggestion in the combination of

¹ For example, while the Patent Office analogizes the base image as being an eye image and the secondary image as being a nose image, overlaying those two images onto each other, as taught by Côté, would result in an unusable facial image.

Miyagaki *et al.* and Côté of a base image that is completely overlaid by a secondary image to form a page window. Thus, Applicant submits that the Patent Office cannot fulfill the “all limitations” prong of a *prima facie* case of obviousness with respect to claim 1, as required by *In re Vaeck*.

Applicant submits that one of skill in the art would not be motivated to combine the two references. *In re Dembiczak* and *In re Zurko* require the Patent Office to provide particularized facts on the record as to why one of skill would be motivated to combine the two references. Without a motivation to combine, a rejection based on a *prima facie* case of obviousness is improper. *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998)). The level of skill in the art cannot be relied upon to provide the suggestion to combine references. *Al-Site Corp. v. VSI Int’l Inc.*, 174 F.3d 1308 (Fed. Cir. 1999). The Patent Office must make specific factual findings with respect to the motivation to combine references. *In re Lee*, 277 F.3d 1338, 1342-44 (Fed. Cir. 2002). Although the Patent Office provides a motivation analysis with respect to modifying static elements, control elements and status elements, both Miyagaki *et al.* and Côté lack any teaching about the desirability of multiple overlaid images to create a page window for a computer system. Neither reference teaches or suggests using images in an overlaid manner for displaying static elements, control elements and status elements. Thus, Applicant submits that the Patent Office cannot fulfill the motivation prong of a *prima facie* case of obviousness with respect to claim 1, as required by *In re Dembiczak* and *In re Zurko*.

Based on the foregoing reasons, Applicant submits that the combination of Miyagaki *et al.* and Côté fails to teach or suggest all of the claimed elements as arranged in claim 1.

Therefore, the combination of Miyagaki *et al.* and Côté clearly cannot render the present invention obvious as recited in claim 1. Applicant submits that claim 1 is allowable, and further submits that claims 2 and 3 are allowable as well, at least by virtue of their dependency from claim 1. Applicant respectfully requests that the Patent Office withdraw the § 103(a) rejection of claims 1-3.

With respect to independent claim 4, Applicant submits that claim 4 is allowable at least for reasons analogous to those discussed above with respect to claim 1, in that the combination of Miyagaki *et al.* and Côté fails to teach or suggest a plurality of page windows, wherein each page window is created by overlaying a retrieved secondary image on a retrieved base image. Applicant submits that claim 4 is allowable, and further submits that claims 5 and 6 are allowable as well, at least by virtue of their dependency from claim 4. Applicant respectfully requests that the Patent Office withdraw the § 103(a) rejection of claims 4-6.

With respect to independent claim 7, Applicant submits that claim 7 is allowable at least for reasons analogous to those discussed above with respect to claim 1, in that the combination of Miyagaki *et al.* and Côté fails to teach or suggest a page window for a computer controlled process, wherein each page window is created by overlaying a retrieved secondary image on a retrieved base image. Applicant submits that claim 4 is allowable, and further submits that claims 8-12 are allowable as well, at least by virtue of their dependency from claim 7. Applicant respectfully requests that the Patent Office withdraw the § 103(a) rejection of claims 7-12.

With respect to dependent claims 14, 17, 18 and 21, Applicant submits that claims 14, 17, 18 and 21 are allowable at least for reasons analogous to those discussed above with respect to

claim 1, in that the combination of Miyagaki *et al.* and Côté fails to teach or suggest a method for displaying page windows for a computer controlled process, wherein each page window is created by overlaying a retrieved secondary image on a retrieved base image (as recited in independent claim 13 and included via dependency in claims 14, 17, 18 and 21). Applicant submits that claims 14, 17, 18 and 21 are allowable, and respectfully requests that the Patent Office withdraw the § 103(a) rejection of claims 14, 17, 18 and 21.

With respect to dependent claims 23, 24 and 27, Applicant submits that claims 23, 24 and 27 are allowable at least for reasons analogous to those discussed above with respect to claim 1, in that the combination of Miyagaki *et al.* and Côté fails to teach or suggest a computer system adapted for displaying page windows, wherein each page window is created by overlaying a retrieved secondary image on a retrieved base image (as recited in independent claim 22 and included via dependency in claims 23, 24 and 27). Applicant submits that claims 23, 24 and 27 are allowable, and respectfully requests that the Patent Office withdraw the § 103(a) rejection of claims 23, 24 and 27.

With respect to independent claim 29, Applicant submits that claim 29 is allowable at least for reasons analogous to those discussed above with respect to claim 1, in that the combination of Miyagaki *et al.* and Côté fails to teach or suggest a method for presenting a page window, wherein each page window is created by overlaying a retrieved secondary image on a retrieved base image. Applicant submits that claim 29 is allowable, and further submits that claims 30-32 are allowable as well, at least by virtue of their dependency from claim 29.

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Applicant respectfully requests that the Patent Office withdraw the § 103(a) rejection of claims 29-32.

With respect to independent claim 33, Applicant submits that claim 33 is allowable at least for reasons analogous to those discussed above with respect to claim 1, in that the combination of Miyagaki *et al.* and Côté fails to teach or suggest a computer system adapted to present a page window, wherein each page window is created by overlaying a retrieved secondary image on a retrieved base image. Applicant submits that claim 33 is allowable, and further submits that claims 34-36 are allowable as well, at least by virtue of their dependency from claim 33. Applicant respectfully requests that the Patent Office withdraw the § 103(a) rejection of claims 33-36.

With respect to independent claim 37, Applicant submits that claim 37 is allowable at least for reasons analogous to those discussed above with respect to claim 1, in that the combination of Miyagaki *et al.* and Côté fails to teach or suggest a computer program product to present a page window for a computer controlled process, wherein each page window is created by overlaying a retrieved secondary image on a retrieved base image. Applicant submits that claim 37 is allowable, and respectfully requests that the Patent Office withdraw the § 103(a) rejection of claim 37.

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In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.


Respectfully submitted,

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